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09/357,585

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GEORGE KOPPICH

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05/19/2004

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EXAMINER

RAHIMI, IRAJ A

ART UNIT

PAPER NUMBER

2622

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/357,585

Applicant(s)

KOPPICH ET AL.

Examiner

(Iraj) Alan Rahimi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on February 2, 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5,9-12 and 23-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1-5,9-12 and 23-30 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) 31 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 September 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. In papers filed on February 2, 2004 applicant amended claims 1, 2, 9-11; canceled claim 14 and added new claims 26-31.

### ***Response to Arguments***

2. Applicant's arguments filed on February 2, 2004 have been fully considered but they are not persuasive. Applicant argues that Shaffer is not seen to disclose transferring a print job including data associated with a user and specific to that user. Examiner disagrees with the applicant's interpretation and considers the selection of the specific images to be associated and specific to that user since the user selected that specific image and it was not randomly provided to the user.

Applicant additionally argues that Bum does not describe a print job received from an Internet-based source. Examiner still disagrees with the applicant since Bum put no limit as what type of data can be transferred from the cable head end to the PC through the set top box. Examiner considers print data as one form of the data being transferred.

Applicant additionally argues that deVries does not teach push-print jobs. Examiner agrees that deVries displays the pushed data and does not print the pushed data. Lewis (US patent application 2003/0040962) is cited in this action for teaching push type printing.

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***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5, 9-11 and 26-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer (US patent 5,793,414) in view of Bum (US patent 6,285,685).

Regarding claim 1, Shaffer discloses a method for providing of an Internet-based print job at a printer connected to an information processing device, a server connected to a plurality of information processing devices executes the steps of:

receiving from an internet-based source a print job to be printed at a printer connected to an information processing device via a network, wherein the print job includes data associated with, and specific to a user of the information processing device;

obtaining a print driver for the printer connected to the information processing device (column 3, lines 27-31);

rendering the print job using the print driver; and

transferring the rendered print job over the network to the information processing device.

However, Shaffer does not teach connectivity to Internet for supply of Internet based printing data. Bum in column 4, lines 23-60 explains how data is transmitted from PC through the set top box to the cable head end and to the Internet gateway. He explains in lines 57-60 that data packet from backbone Internet can be sent to the PC by reversing the steps explained in the earlier teaching in the same column. In short Bum teaches

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supply of data from Internet to PC through set top box. Examiner interprets data to include print data. Shaffer and Bum are analogous art because they are from the same field of endeavor that is interactive data communication. Therefore, it would have been obvious to a person skilled in the art, at the time of invention to combine Bum with Shaffer to increase print data availability beyond what is stored in the program content storage 20.

Regarding claim 2, Shaffer discloses a method according to Claim 1, further comprising the steps of instructing the information processing device to create a logical printer with a simplified print driver that accepts rasterized bit map print jobs, and of accepting the rasterized bit map print job by the logical printer for visual printout (column 3, lines 43-55).

Regarding claim 3, Shaffer discloses a method according to Claim 1, wherein the rasterized bit map image created at the cable head end includes all needed printer commands for the target printer (column 3, lines 27-30).

Regarding claim 4, Shaffer discloses a method according to Claim 3, wherein the rasterized bit map print data is formatted to a format needed by the target printer (column 3, lines 27-30).

Regarding claim 5, Shaffer discloses a method according to Claim 1, further comprising the step, at cable head end, of automatically detecting the identification

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information for the type and configuration of printer attached to the set top box, by requesting such information from the set top box, and thereafter automatically obtaining a suitable print driver (column 3, lines 27-30 & lines 43-55).

Regarding claim 9, Bum discloses an apparatus for providing for printout of an internet-based print job at a printer connected to a set top box, in which the set top box is connected to a cable head end via a digital cable network, comprising:

a program memory for storing process steps executable to perform a method according to any of Claims 1 to 5, 12, 23 to 25, 30 and 31; and

a processor (CPU 86) for executing the process steps stored in said program memory (Memory 84).

Regarding claims 10 and 11, arguments analogous to those presented for claim 9, are applicable.

Regarding claim 26, Bum discloses a method according to claim 1, wherein the information processing device is a set top box 40, the network is broadband network 30 and the server is a cable head end 10.

Regarding claims 27-29 arguments analogous to those presented for claim 26, are applicable.

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Regarding claim 30, Shaffer discloses a method according to claim 1, wherein the data is generated based on a request from the user of the information processing device, set top box 14 (column 3 lines 10-18).

5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer (US patent 5,793,414) in view of Bum (US patent 6,285,685) and further in view of Lewis (US patent application 2003/0040962).

Regarding claim 12, Shaffer and Bum do not teach a method according to Claim 1, wherein the Internet-based print job is a push-print job originating from an Internet-based source. Lewis teaches in paragraphs 88 and 104 discloses delivery of data from cable signal via Internet. He continues to teach that data may be print data in either push or pull technology. Shaffer, Bum and Lewis are analogous art because they are from the same field of endeavor that is electronic delivery of data. Therefore, it would have been obvious to a person skilled in the art, at the time of invention to combine push printing of Lewis with Shaffer and Bum for target advertising to the individual preferences of the user.

6. Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer (US patent 5,793,414) in view of Bum (US patent 6,285,685) and further in view of Davis et al. (US patent 6,367,009).

Regarding claim 23, Shaffer in view of Bum does not disclose a method according to claim 1, further comprising the steps of establishing a secure connection to

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the internet-based source. However, Davis discloses in column 10, lines 19-51 establishing secure communication between the client and the server. Shaffer, Bum and Davis are analogous art because they are from the same field of endeavor that is communication between devices in a network environment. Therefore, it would have been obvious to a person skilled in the art, at the time of invention to combine Davis with Shaffer in view of Bum to protect e-commerce transactions.

Regarding claim 24, arguments analogous to those presented for claim 23, are applicable.

7. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer (US patent 5,793,414) in view of Bum (US patent 6,285,685) and further in view of Yamaguchi (US patent 5,832,301).

Regarding claim 25, Shaffer in view of Bum does not teach a method according to claim 1, wherein the step of rendering the print job generates rasterized data using the print driver. However, this well-known topic in art is disclosed by Yamaguchi in column 7, lines 11-16. Shaffer in view of Bum and Yamaguchi are analogous art because they are from the same field of endeavor that is generating and transferring print data. Therefore, it would have been obvious to a person skilled in the art, at the time of invention to use a print driver for to adapt the print data from an application for a specific printer.



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***Allowable Subject Matter***

8. Claim 31 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art and the prior art of record do not disclose determining whether to accept the push-print job received from Internet-based source based on profile information associated with the user in connection with the limitations of claims 12 and 1 which claim 31 depends on.

***Other Prior Art Cited***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Vishwanath et al. (US patent 6,216,157) defines push-printing.

***Contact Information***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to (Iraj) Alan Rahimi whose telephone number is 703-306-3473. The examiner can normally be reached on Mon.-Fri. 7:30-4:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L Coles can be reached on 703-305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AR

Alan Rahimi  
May 10, 2004

  
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